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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
|-----------------|-------------|----------------------|---------------------|------------------|

10/804,811

03/19/2004

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03/14/2008

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EXAMINER

DUNHAM, JASON B

ART UNIT

PAPER NUMBER

3625

MAIL DATE

DELIVERY MODE

03/14/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 10/804,811 | Applicant(s) SELINGER ET AL. | |
| | Examiner JASON B. DUNHAM | Art Unit 3625 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/30/07.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/30/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

Applicant amended claim 20 in the response filed November 30, 2007 in reply to the office action dated July 3, 2007. Claims 10-20 are pending.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 20 is rejected under 35 U.S.C. 101.

Referring to claim 20. Claims to computer-related inventions that are clearly nonstatutory fall into the same general categories as nonstatutory claims in other arts, namely natural phenomena such as magnetism, and abstract ideas or laws of nature which constitute “descriptive material.” Abstract ideas, Warmerdam, 33 F.3d at 1360, 31 USPQ2d at 1759, or the mere manipulation of abstract ideas, Schrader, 22 F.3d at 292-93, 30 USPQ2d at 1457-58, are not patentable. Descriptive material can be characterized as either “functional descriptive material” or “nonfunctional descriptive material.” In this context, “functional descriptive material” consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of “data structure” is “a physical or logical relationship among data elements, designed to support specific data manipulation functions.” The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).)

Art Unit: 3625

“Nonfunctional descriptive material” includes but is not limited to music, literary works and a compilation or mere arrangement of data. Both types of “descriptive material” are nonstatutory when claimed as descriptive material per se. Warmerdam, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Claim 20 recites a mere arrangement of data which does not impart functionality when employed as computer component.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 20 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 20 recites a mere arrangement of data and does not constitute a system, method, or apparatus.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gross (US 2004/0260600) in view of Walker (US 6,049,778).

Referring to claim 10. The combination of Gross and Walker discloses a method in a computing system for characterizing an item, comprising:

- Determining a score for the item reflecting the extent to which the item has been ordered by customers who have been determined to commonly order items promptly after they become available (Gross: paragraphs 19 and 31-32); and
- Scaling the score in a manner that causes to positively relate to the item's price and negatively relate to the amount of time that has elapsed since the item became available for ordering (Walker: abstract and figures 3-7). The examiner notes that Walker discloses rewards for early adopters that positively depend upon the cost of the item they purchased and when the item was purchased.

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have modified the method of Gross to have included scaling a score in a manner that causes to positively relate to the item's price and negatively relate to the amount of time that has elapsed since the item became available for ordering, as taught by Gross, in order to provide early purchasers with incentive to buy the product early in the life cycle of the product and thereby promote the product (Walker: column 4, lines 4-15).

Referring to claim 11. The combination of Gross and Walker further discloses a method wherein an item detail web page is associated with the product, the method

further comprising including in the item detail web page an indication of the item's scale score (Gross: paragraph 43).

Referring to claim 12. The combination of Gross and Walker further discloses a method wherein the included indication explicitly indicates the item's scaled score (Gross: paragraph 43).

Referring to claim 13. The combination of Gross and Walker further discloses a method wherein the included indication explicitly indicates a range into which the item's scaled score falls (Gross: paragraph 191).

Referring to claim 14. The combination of Gross and Walker further discloses a method wherein the included indication indicates a relationship between the item's scaled score and scale scores for additional items (Gross: paragraph 191).

Referring to claim 15. The combination of Gross (figure 1 and paragraph 88) and Walker (figure 2 and column 5, line 49 – column 6, line 18) disclose all of the above as noted under the rejection of claims 10-14 further discloses a computer readable medium whose contents cause a computing system to characterize items by: for each of a plurality of items:

- Storing indications identifying at least a portion of the items having the highest scores (Gross: paragraph 191).

Referring to claim 16. The combination of Gross and Walker further discloses a computer readable medium wherein the contents of the medium cause the computer system to store in conjunction with the stored indications the scores determined for the corresponding items (Gross: figure 5A).

Referring to claim 17-19. The combination of Gross and Walker further discloses a computer readable medium wherein the contents of the medium cause the computer system to generate a document, transmit to customers, and transmit to make available for retrieval by customers a document identifying at least a portion of the items having the highest scores (Gross: paragraph 43).

Referring to claim 20. Claim 20 is rejected under the same rationale set forth above.

Response to Arguments

Applicant's arguments filed November 30, 2007 have been fully considered but they are not persuasive. Applicant's arguments regarding the 35 USC 101 and 112 rejections are not persuasive because the computer memories of claim 20 merely store data, see the requirement of descriptive data to be "functional" noted above in the 35 USC 101 rejection. Claim 20 stores information identifying a product and a related score but there is no recitation of transforming the data to produce a result.

Applicant further argues that the combination of Gross and Walker does not disclose the last limitation of claim 1. The examiner disagrees. Gross clearly discloses ranking items ordered by "early adopters" and generating a demand score for said item that quantifies remaining demand by "late adopters" as time passes (see at least paragraphs 19 and 31-33). Gross does not explicitly disclose scaling the score based on the item's price (as noted in the office action dated July 3, 2007). Walker discloses scaling a score ordered by early adopters according to item price as noted by the cited

portions in the rejection of claim 1. Applicant's argument that Walker merely discloses ordinal positions is unpersuasive as the ordinal positions of the early adopter are clearly based on the time when an item is purchased. Walker's ordinal positions meet the limitation of "amount of time elapsed", as recited in claim 1.

Lastly, see the above paragraph regarding applicant's arguments against the rejection of claim 20. The examiner suggests amending claim 20 to impart functionality to the descriptive material in order meet the requirements of 35 USC 101 and 112. The examiner also suggests amending independent claims 10 and 15 to include display of the item score with the item detail web page and an indication of its relevancy to other item scores.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JASON B. DUNHAM whose telephone number is (571)272-8109. The examiner can normally be reached on M-F, 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Matthew S Gart/
Primary Examiner, Art Unit 3625

JBD
Patent Examiner
2/29/08